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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,667	08/07/2001	Gayle Hargrave-Thomas	5658/749	3666

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EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

8c

Office Action Summary

Application No.

09/924,667

Applicant(s)

HARGRAVE-THOMAS, GAYLE

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22-30 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 and 25 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-20, 22, 23, 26-30 and 33-35 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office action acknowledges the applicant's amendment presented as Paper No. 5. Claims 1-20, 22-30 and 33-35 are pending in the application. Claims 21, 31-32 and 36-37 have been cancelled.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore the square shape of claim 9, the cotter pin of claim 20, and the divider of claims 22, 33 and 35 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office Action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. In light of the applicant's amendment, the objection to the specification is hereby withdrawn.

Claim Rejections - 35 USC § 112

5. In light of the applicant's amendment, the rejections of claims 24 and 25 under 35 U.S.C. 112, second paragraph, are hereby withdrawn.

Claim Rejections - 35 USC § 102

6. In light of the applicant's amendment, the rejections of claims 34 and 35 under 35 U.S.C. 102(b) are hereby withdrawn.

Claim Rejections - 35 USC § 103

7. Claims 1-5, 7-8, 11, 16-18, 20, and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhard (US 3,053,424) in view of Fuller (US 1,137,126).

Regarding claim 1, Reinhard discloses a carry case with front member (22), rear member (21), spindle (12), and handle (44) attached to rear member (21). Front member (22) and rear member (21) together form a frame body larger than the diameter of at least one circular saw blade, and retaining a varying number of said saw blades by spindle (12, Figure 1). The frame body is not a closed structure and the article held is viewable, at least in part, from the side edges (as shown, Figure 1). Reinhard teaches ribs to add stiffness (Col. 2, ll. 65-67).

Reinhard does not describe crossbars extending across the front and rear members.

Fuller discloses a shipping container with crossbars (5) extending across the front and rear members (2). It would have been obvious to one of ordinary skill in the

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art at the time the invention was made to modify Reinhard with the crossbars of Fuller in order to enhance the stiffness of members (21) and (22).

As to claim 2, the case of Reinhard-Fuller would have crossbars extending over the substantial center of the front and rear members (Fuller, Figure 2).

Regarding claims 3-5, the case of Reinhard-Fuller discloses a spindle (Reinhard, 12) removably received by receptacle (Reinhard 23) on member (Reinhard 22). Spindle (Reinhard 12) extends through the substantial centers of members (Reinhard 21 and 22) and passes through an arbor hole of blades (Reinhard 5,6, 7, and 8).

Reinhard-Fuller does not disclose a spindle attached to a member. It would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the spindle a member through a rudimentary means such as welding as such a retention is conventional in the fastener art.

As to claims 7-8, Reinhard-Fuller discloses members (Reinhard 21 and 22) that are substantially parallel (Reinhard Figure 1) and Fuller describes members (Fuller 2) that are circular in shape.

As to claim 11, the case of Reinhard-Fuller discloses the claimed invention except for a frame body constructed from a heavy plastic. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Reinhard-Fuller constructed of a heavy plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As to claims 16-17, the case of Reinhard-Fuller would have a panel area on member (Reinhard 22) created by the crossbars suitable for retaining an advertisement. Said panel area would be less than one-half of member (Reinhard 22).

As to claims 18 and 20, the case of Reinhard-Fuller discloses spindle (Reinhard 12) with fastening means (Reinhard 54). Fastening means (Reinhard 54) is threaded, however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use any number of conventional fastening means commonly known in the art, including cotter pins, to secure member (Reinhard 22).

As to claim 22, the case of Reinhard-Fuller discloses dividers (Reinhard 51) for separating blades (Reinhard 5-8).

8. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhard in view of Fuller as applied to claim 1 above, and further in view of Wiepert (US 2,636,641).

The case of Reinhard-Fuller meets all limitations claimed by the applicant except for the retractable handle with handle receptacles.

Wiepert discloses a pivotal handle (20) for a container that is retractable towards its mounting plane. Handle (20) is inserted into handle receptacles (16) and (17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the handle of Wiepert to the case of Reinhard-Fuller in order to reduce the overall size of the case. The examiner notes that such a folding handle is common and conventional in the container art.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhard in view of Fuller as applied to claim 1 above, and further in view of Rackley (US 5,078,266).

The case of Reinhard-Fuller meets all limitations claimed by the applicant except for the square shape.

Rackley discloses a saw blade housing (10) with front member (12) and rear member (11) having a square shape. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the case of Reinhard-Fuller with the square shape taught by Rackley to facilitate vertical storage.

10. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhard in view of Fuller as applied to claim 1 above, and further in view of Hirose et al. (US 4,955,471).

The case of Reinhard-Fuller meets all limitations claimed by the applicant except for the outer covering.

Hirose et al. discloses a shipping container (11) with a plurality of packing methods. Hirose et al. discloses an outer covering (25) attached to the perimeter of the front and rear members (Figures 8(a)-8(d)) and an outer covering band (14) not attached to the front and rear members (Figures 6(a)-6(b)). Hirose et al. further discloses bands (23) of polypropylene (Col. 8, ll. 7-8), of which EMPP (elastomer-modified polypropylene) is a sub group, and cover (14) of paper or plastic film (Col. 7, ll.

5-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the case of Reinhard-Fuller with covers as taught by Hirose et al. in order to protect the contents during shipping and storage.

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhard in view of Fuller as applied to claims 1 and 18 above, and further in view of Stanley (US 4,784,263).

The case of Reinhard-Fuller meets all limitations claimed by the applicant except for a threaded receptacle opening.

Stanley discloses a saw blade carrier (10) with a threaded shaft (18) and a threaded receptacle opening (22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the case of Reinhard-Fuller with a threaded shaft and a threaded receptacle opening as taught by Stanley as an alternate form of fastening since such a connection is common and conventional in the fastener art.

12. Claims 1-5, 7, 8, 11, 18, 22, 26-30, 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lueth (Des. 314,471) in view of Reinhard.

Regarding claim 1, Lueth discloses a rear member having at least one crossbar, a spindle, and a handle (as shown, Figures 1-7).

Lueth does not disclose a front member connected to the rear member by way of the spindle and adjustable to accommodate a varying number of blades.

Reinhard discloses a case (Figure 1) with a front member (22) connected to the rear member (21) by way of the spindle (12) and adjustable to accommodate a varying number of blades. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Lueth with a front member arrangement as taught by Reinhard in order to accommodate a varying number of blades. It would have further been obvious to include the crossbar arrangement of the rear member in the fabrication of the front member in order to maintain the aesthetic qualities of the case.

As to claim 2, the case of Lueth-Reinhard discloses crossbars over the substantial centers of the members.

As to claims 3-5, the case of Lueth-Reinhard discloses a spindle (Reinhard, 12) removably received by receptacle (Reinhard 23) on member (Reinhard 22). Spindle (Reinhard 12) extends through the substantial centers of members (Reinhard 21 and 22) and passes through an arbor hole of blades (Reinhard 5,6, 7, and 8).

As to claim 7, the case of Lueth-Reinhard discloses front and rear members substantially parallel (Reinhard Figure 1).

As to claim 8, the case of Lueth-Reinhard discloses front and rear members that are circular in shape (Lueth, Figure 1 and Reinhard, Figure1).

As to claim 11, the case of Lueth-Reinhard discloses the claimed invention except for a frame body constructed from a heavy plastic. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Reinhard-Fuller constructed of a heavy plastic, since it has been held to be within the

general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As to claim 18, the case of Lueth-Reinhard discloses fastening means (Reinhard 54).

As to claim 22, the case of Lueth-Reinhard discloses dividers (Reinhard 51) for separating blades (Reinhard 5-8).

Regarding claim 26, Lueth discloses a rear member having at least one crossbar, a spindle, and a handle (as shown, Figures 1-7).

Lueth does not disclose a front member connected to the rear member by way of the spindle and adjustable to accommodate a varying number of blades.

Reinhard discloses a case (Figure 1) with a front member (22) connected to the rear member (21) by way of the spindle (12) and having a gap to accommodate a varying number of blades. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Lueth with a front member arrangement as taught by Reinhard in order to accommodate a varying number of blades. It would have further been obvious to include the crossbar arrangement of the rear member in the fabrication of the front member in order to maintain the aesthetic qualities of the case.

As to claim 27, the case of Lueth-Reinhard discloses a spindle (Reinhard 12).

As to claim 28, Lueth discloses a spindle attached to the rear member, and Reinhard discloses a spindle received through a receptacle on the front member.

As to claims 29 and 30, the case of Lueth-Reinhard discloses a spindle (Reinhard 12) extending through the substantial centers of members (Lueth Figure 1 and Reinhard 22) and passing through an arbor hole of blades (Reinhard 5,6, 7, and 8).

As to claim 33, the case of Lueth-Reinhard discloses dividers (Reinhard 51) for separating blades (Reinhard 5-8).

Regarding claim 34, Lueth discloses a generally flat rear member having at least one crossbar, a spindle, a retention means, and a handle (as shown, Figures 1-7).

Lueth does not disclose a front member connected to the rear member by way of the spindle and adjustable to accommodate a varying number of blades.

Reinhard discloses a case (Figure 1) with a generally flat front member (22) connected to the generally flat rear member (21) by way of the spindle (12) and having a gap to accommodate a varying number of blades. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Lueth with a front member arrangement as taught by Reinhard in order to accommodate a varying number of blades. It would have further been obvious to include the crossbar arrangement of the Lueth rear member in the fabrication of the front member in order to maintain the aesthetic qualities of the case.

As to claim 35, the case of Lueth-Reinhard discloses dividers (Reinhard 51) for separating blades (Reinhard 5-8).

Allowable Subject Matter

13. Claims 24-25 are allowable over the prior art of record.

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14. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

16. Regarding claims 1-8, 11-18, 20, 22, and 23, in response to applicant's argument that Fuller is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Fuller is reasonably pertinent to cover stiffness in a case holding a plurality of disk shaped objects.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a saw blade viewed at least in part through the frame") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner interprets the terms "front

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member” and “rear member” to correspond to the plates of Reinhard and the term “frame body” (recited in the claim) as corresponding to the assembly as a whole. As such, while the blades are not visible through the individual frame members, the blade edges are visible, at least in part, through the frame body.

17. Regarding claim 9, in response to applicant's argument that Rackley contemplates an enclosed structure, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Rackley merely suggests a square shape to prevent rolling.

18. Regarding claim 19, in response to applicant's argument that Stanley “is enclosed in order to prevent water from entering the carrier”, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Stanley suggests making threads integral to a receptacle opening.

19. Applicant's arguments, see page 6, fourth paragraph; and page 7, second paragraph, of applicant's Amendment A, filed March 24, 2003, with respect to the rejection(s) of claim(s) 10, 26-30, and 33 under 35 U.S.C 103(a), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art, Lueth (Des. 314,471), applied above.

Conclusion

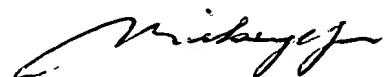
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Gregory Pickett
Examiner
May 6, 2003



Mickey Yu
Supervisory Patent Examiner
Group 3700